



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,869	07/02/2001	Uwe Hansmann	DE20000028US1	1390

7590 11/01/2004

William A. Kinnaman, Jr.  
IBM Corporation  
Intellectual Property Law Department  
2455 South Road M/S P386  
Poughkeepsie, NY 12601

EXAMINER

ROSEN, NICHOLAS D

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/897,869

**Applicant(s)**

HANSMANN ET AL.

**Examiner**

Nicholas D. Rosen

**Art Unit**

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1-28 have been examined.

#### ***Claim Objections***

Claim 5 is objected to because of the following informalities: "the associated vendor" lacks antecedent basis. Appropriate correction is required.

Claim 10 is objected to because of the following informalities: "the vendor" lacks antecedent basis. Furthermore, claim 10 appears to recite that the hardware interface is adapted to the functionality of the interface, which appears to be a tautology. Appropriate correction is required.

Claims 13-18 are objected to because of the following informalities: It is unclear whether "multiple, vendor-specific product information" means multiple items of information about a single product of a specific vendor, or items of information about multiple products of a specific vendor, or information about a product available from multiple specific vendors. Appropriate correction is required.

Claim 17 is objected to because of the following informalities: "the associated vendor" lacks antecedent basis. Appropriate correction is required.

Claims 19-27 are objected to because of the following informalities: It is unclear whether "multiple, vendor-specific product information" means multiple items of information about a single product of a specific vendor, or items of information about multiple products of a specific vendor, or information about a product available from multiple specific vendors. Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 11 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 11 as written appears to claim a computer program *per se*, which is non-statutory. The claim is directed to an abstraction not within the technological arts ("technological arts" being considered equivalent to "useful arts," mentioned in Article I, Section 8 of the United States Constitution, saying that Congress shall have "power to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writing and Discoveries" – see *In re Musgrave*, 431 F.2d 882, 167 USPQ [CCPA 1970]). A computer program *per se* is held to be not within the technological arts. It is, however, possible to claim a computer-readable medium, containing computer-executable code, which, when executed on a computer, cause the computer to carry out a series of steps with a useful, concrete, and tangible result.

Claim 25 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 25 as written appears to claim a computer program *per se*, which is non-statutory. The claim is directed to an abstraction not within the technological arts ("technological arts" being considered equivalent to "useful arts," mentioned in Article I, Section 8 of the United States Constitution, saying that Congress shall have "power to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the

exclusive Right to their respective Writing and Discoveries” – see *In re Musgrave*, 431 F.2d 882, 167 USPQ [CCPA 1970]). A computer program *per se* is held to be not within the technological arts. It is, however, possible to claim a computer-readable medium, containing computer-executable code, which, when executed on a computer, cause the computer to carry out a series of steps with a useful, concrete, and tangible result.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

### **Claims 1, 2, 4, 5, 6, and 10**

Claims 1, 2, 4, 5, 6, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Swartz et al. (U.S. Patent 5,923,735). As per claim 1, Swartz discloses a customer-associated shopping communications method in which product information is provided to a customer of a shop via an electronic shopping system, comprising the steps of: importing product information into a customer-associated mobile computing device (Figures 3 and 5; column 3, line 38, through column 4, line 3; column 6, lines 11-18; column 7, lines 30-66; column 8, line 56, through column 9, line 21); and storing the product information or a reference to it for retrieving after import (column 9, line 49, through column 11, line 30; column 12, lines 16-66).

As per claim 2, Swartz discloses the step of importing sales-related additional information for a product (column 7, lines 37-40; column 9, lines 49-65).

As per claim 4, Swartz discloses the step of creating an order for a product (column 9, line 65, through column 10, line 10; column 10, line 42, through column 11, line 5; Figures 7 and 8).

As per claim 5, Swartz discloses the step of sending the order for the product to the associated vendor (column 10, line 42, through column 11, line 5; Figure 8).

As per claim 6, Swartz discloses the step of initiating a payment for a product (Figure 8; column 11, lines 18-30).

As per claim 10, Swartz discloses a hardware interface between the customer computing device and the vendor (Figure 1; column 6, lines 19-24), and said hardware interface, to carry out its described functions, must inherently be "adapted to the functionality of the interface."

#### **Claims 13, 14, 16, and 17**

Claims 13, 14, 16, and 17, are rejected under 35 U.S.C. 102(e) as being anticipated by Swartz et al. (U.S. Patent 5,923,735). As per claim 13, Swartz discloses a mobile computer device comprising: means for importing multiple, vendor specific product information (Figures 1, 3 and 5; column 3, line 38, through column 4, line 3; column 6, lines 11-24; column 7, lines 30-66; column 8, line 56, through column 9, line 21); and storing the product information or a reference to it for retrieving after import (column 9, line 49, through column 11, line 30; column 12, lines 16-66).

As per claim 14, Swartz discloses means for importing sales-related additional information for a product (column 7, lines 37-40; column 9, lines 49-65).

As per claim 16, Swartz discloses means for creating an order for a product (column 9, line 65, through column 10, line 10; column 10, line 42, through column 11, line 5; Figures 7 and 8).

As per claim 17, Swartz discloses means for sending the order for the product to the associated vendor (column 10, line 42, through column 11, line 5; Figure 8).

**Claims 19, 20, 22, 23, and 27**

Claims 19, 20, 22, 23, and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Swartz et al. (U.S. Patent 5,923,735). As per claim 19, Swartz discloses a shop-associated shopping communications method in which product information is provided to a computing device associated to a customer, comprising the step of: providing an export of multiple, vendor-specific product information into the customer-associated computing device (Figures 3 and 5; column 3, line 38, through column 4, line 3; column 6, lines 11-24; column 7, lines 30-66; column 8, line 56, through column 9, line 21).

As per claim 20, Swartz discloses the step of exporting sales-related additional information for a product (column 7, lines 37-40; column 9, lines 49-65).

As per claim 22, Swartz discloses the step of receiving and processing an order for the product (column 9, line 65, through column 11, line 5; Figure 8).

As per claim 23, Swartz discloses the step of receiving a payment for the product (column 11, lines 18-23).

As per claim 27, Swartz discloses a computer having means for performing the method of claim 19 (Figure 3; column 3, line 16, through column 4, line 3; column 7, lines 30-40).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 3, 7-9, 11 and 12**

Claims 3, 8, 9, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz (U.S. Patent 5,923,735) as applied to claim 1 above, and further in view of official notice. As per claim 3, Swartz does not disclose the step of importing delivery-related information for a product, although Swartz does disclose



importing various other information for a product (note column 7, lines 37-40; and column 9, lines 49-65). However, official notice is taken that it is well known to provide delivery-related information for a product (e.g., information on the availability of delivery, the charges, if any, for delivery, and solicitation of information on the address to which a customer wants a product delivered, etc.). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the method to further comprise the step of importing delivery-related information for a product, for the obvious advantage of arranging delivery of the product, especially in cases where the product was either too large and heavy to be conveniently taken home by the customer (e.g., furniture), or not available immediately, but requiring, for example, a special order from a wholesaler.

As per claim 8, Swartz does not expressly disclose that a standardized interface is used for implementing the multiplicity of steps, but official notice is taken that it is well known to use standardized interfaces (that is almost the definition of "standardized"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use a standardized interface for implementing the multiplicity of steps, for the obvious advantage of being able to buy off-the-shelf hardware and/or write programs in familiar computer languages, etc., rather than having to invent, make, and debug something entirely new.

As per claim 9, Swartz does not disclose that XML is used for programming, but official notice is taken that XML is well known. Hence, it would have been obvious to

one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use XML for programming, for the advantage set forth in the preceding paragraph.

As per claim 11, Swartz does not expressly disclose a computer program comprising code portions adapted for performing the steps according to the method according to claim 1 when the program (i.e., a computer readable medium on which the program is embodied) is loaded into a computer device, although Swartz does disclose programming in the computer devices used in his method (column 5, lines 3-5 and 39-53; column 7, lines 5-8). Moreover, official notice is taken that computer programs for causing computers to carry out procedures are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use a computer program comprising code portions adapted for performing the steps according to the method according to claim 1 when the program (i.e., a computer readable medium on which the program is embodied) is loaded into a computer device, for the obvious advantage of enabling the computers disclosed by Swartz to perform their functions.

As per claim 12, Swartz does not expressly disclose a computer program product stored on a computer usable medium comprising computer readable program means for causing a computer to perform the method according to claim 1, although Swartz does disclose programming in the computer devices used in his method (column 5, lines 3-5 and 39-53; column 7, lines 5-8). Moreover, official notice is taken that computer programs stored on computer usable media for causing computers to carry out procedures are well known. Hence, it would have been obvious to one of ordinary skill

in the art of electronic commerce at the time of applicant's invention to use a computer program product stored on a computer usable medium comprising computer readable program means for causing a computer to perform the method according to claim 1, for the obvious advantage of enabling the computers disclosed by Swartz to perform their functions.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz (U.S. Patent 5,923,735) as applied to claim 1 above, and further in view of Majer ("License to Bill"). Swartz does not disclose the step of evaluating the product information with respective information associated to products from other vendors, but Majer teaches doing this (entire article, especially last two sentences). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to evaluate the product information with respective information associated to products from other vendors, for the stated advantage finding the lowest price.

### **Claims 15 and 18**

Claims 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz (U.S. Patent 5,923,735) as applied to claim 13 above, and further in view of official notice. As per claim 15, Swartz does not disclose means for importing delivery-related information for a product, although Swartz does disclose importing various other information for a product (note column 7, lines 37-40; and column 9, lines 49-65), and the mobile computing device of Swartz certainly could be used to import delivery-related information, or whatever other information someone chose to transmit. However, official

notice is taken that it is well known to provide delivery-related information for a product (e.g., information on the availability of delivery, the charges, if any, for delivery, and solicitation of information on the address to which a customer wants a product delivered, etc.). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the device to further comprise means for importing delivery-related information for a product, for the obvious advantage of arranging delivery of the product, especially in cases where the product was either too large and heavy to be conveniently taken home by the customer (e.g., furniture), or not available immediately, but requiring, for example, a special order from a wholesaler.

As per claim 18, Swartz discloses means for initiating a payment for a product (Figure 8; column 11, lines 18-30), but does not expressly disclose that the mobile computing device comprises said means. However, official notice is taken that it is well known for mobile computing devices to comprise means for initiating payment for a product (e.g., using a mobile phone to transmit credit card information). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the mobile computing device to further comprise means for initiating payment, for the obvious advantage of enabling the customer to conveniently initiate payment particularly in cases where the vendor is remote from the customer, and thus cannot easily accept cash, a check, or a physical credit card.

**Claims 21, 24-26 and 28**

Claims 21, 24, 25, 26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz (U.S. Patent 5,923,735) as applied to claim 19 above, and further in view of official notice. As per claim 21, Swartz does not disclose the step of exporting delivery-related information for a product, although Swartz does disclose exporting various other information for a product (note column 7, lines 37-40; and column 9, lines 49-65). However, official notice is taken that it is well known to provide delivery-related information for a product (e.g., information on the availability of delivery, the charges, if any, for delivery, and solicitation of information on the address to which a customer wants a product delivered, etc.). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the method to further comprise the step of exporting delivery-related information for a product, for the obvious advantage of arranging delivery of the product, especially in cases where the product was either too large and heavy to be conveniently taken home by the customer (e.g., furniture), or not available immediately, but requiring, for example, a special order from a wholesaler.

As per claim 24, Swartz does not disclose that XML is used for programming, but official notice is taken that XML is well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use XML for programming, for the obvious advantage of performing the programming in a widely known language, which many computers can accept, and with which many programmers are familiar, and able to use.

As per claim 25, Swartz does not expressly disclose a computer program comprising code portions adapted for performing the steps according to the method according to claim 19 when the program (i.e., a computer readable medium on which the program is embodied) is loaded into a computer device, although Swartz does disclose programming in the computer devices used in his method (column 5, lines 3-5 and 39-53; column 7, lines 5-8). Moreover, official notice is taken that computer programs for causing computers to carry out procedures are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use a computer program comprising code portions adapted for performing the steps according to the method according to claim 19 when the program (i.e., a computer readable medium on which the program is embodied) is loaded into a computer device, for the obvious advantage of enabling the computers disclosed by Swartz to perform their functions.

As per claim 26, Swartz does not expressly disclose a computer program product stored on a computer usable medium comprising computer readable program means for causing a computer to perform the method according to claim 19, although Swartz does disclose programming in the computer devices used in his method (column 5, lines 3-5 and 39-53; column 7, lines 5-8). Moreover, official notice is taken that computer programs stored on computer usable media for causing computers to carry out procedures are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use a computer program product stored on a computer usable medium comprising computer readable

program means for causing a computer to perform the method according to claim 19, for the obvious advantage of enabling the computers disclosed by Swartz to perform their functions.

As per claim 28, Swartz does not disclose that the device according to claim 27 is connectable to a goods database of a warehouse, but official notice is taken that it is well known for computing devices in stores to be connectable to the goods databases of warehouses. (Examiner has had the experience, for example, of inquiring about a book in a bookstore, and having the store clerks look it up in a computer, and say something like, "We don't have that here, but they have that in stock in the warehouse; we can order it, and you should have it within five days.") Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the store computing device be connectable to a goods databases of a warehouse, for the obvious advantage of determining whether desired goods were available in a warehouse, and ordering them if a customer so wished.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Swartz et al. (U.S. Patent 6,243,447) disclose a self-service checkout system utilizing a portable communications terminal. Burke et al. (U.S. Patent 6,604,681) disclose an evaluative shopping assistant system. Rothschild (U.S. Patent 6,651,053) discloses an interactive system for investigating products on a network. Martin et al. (U.S. Patent 6,795,707) disclose methods and systems for correlating

telecommunication antenna infrastructure placement information to provide telecommunication quality of service information (see especially column 17, lines 32-44, for relevance to the instant application).

Turner (U.S. Patent Application Publication 2001/0024174) discloses transactions and business processes executed through a wireless geolocation system infrastructure (see especially paragraphs 34-36). Gusick et al. (U.S. Patent Application Publication 2001/0047270) disclose a customer service system and method (see especially paragraph 80). Hill et al. (U.S. Patent Application Publication 2002/0078363) disclose an apparatus and method for gathering and utilizing data. Busis et al. (U.S. Patent Application Publication 2002/0085025) disclose a universal electronic commerce platform combining browsing, buying, and item registry.

Wakabayashi (Japanese Published Patent Application 11-041170 A) discloses a shopping information system using mobile phones for department stores.

Adams ("Take an Order!") discloses adding items to orders by scanning barcodes, etc. The anonymous article, "JP Systems, BarPoint.com to Debut Wireless In-Store Comparison Shopping on Handheld Devices," discloses what the title suggests. Prangle ("Interactive: Buyer Power Keeps Firms on Their Toes") discloses searching for products available online by a bar code, which may be typed in or scanned from store shelves. Baeb ("Windows Shoppers: Retailers Eyeing Internet to Boost In-Store Sales") discloses using handheld devices to scan barcodes of items in stores, for possible later purchase. Lang ("Clicks Meet Bricks") discloses using handheld devices to scan barcodes of items in stores, for possible later purchase. The anonymous article "Blue



Martini Software Announces Customer Interaction System Version 3.1 Extending Reach to International Markets," discloses using mobile wireless to deliver up-to-date product and service information to customers and in-store sales staff.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Non-official/draft communications can be faxed to the examiner at 703-746-5574.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Nicholas D. Rosen*  
**NICHOLAS D. ROSEN**  
**PRIMARY EXAMINER**

October 27, 2004